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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,040	02/17/2004	Klaus Leyendecker	LIP011DIV	9266

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GROSSMAN, TUCKER, PERREAULT & PFLEGER, PLLC  
55 SOUTH COMMERICAL STREET  
MANCHESTER, NH 03101

EXAMINER
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KEASEL, ERIC S

ART UNIT	PAPER NUMBER
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3754

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

10/780,040

Applicant(s)

LEYENDECKER ET AL.

Examiner

Eric Keasel

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-6, 12 and 13 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4, 6, 12 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Feb 17, 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 10/156,253.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/1/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election of Species B in the reply filed on August 30, 2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 3 and 5 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on August 30, 2004.
3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### *Drawings*

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the induction system, induction ducts, cylinder head, and internal combustion engine must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet,

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even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### *Claim Objections*

5. Claims 12 (line 9) and 13 (line 6) are objected to because it appears that "rotably" should be --rotatably--. Appropriate correction is required.

#### *Claim Rejections - 35 USC § 112*

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 4, 6, 12, and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In each of the independent claims, the relationship between the number of control elements (flap devices) to the number of openings (conduits) to the number of shaft portions is vague and indefinite. For example, claim 13 recites a plurality of control elements each

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arrangeable in a conduit. Does this mean that a single conduit must have multiple control elements? Claim 12 has a similar ambiguity in that the plurality of openings are fitted with flap devices.

In claim 12, “the induction system”, “the cylinder head”, and “the respective openings” lack clear antecedent basis in the claims. In claim 13, line 3, it is unclear if “a conduit” is meant to be one of the previously recited “conduits” in line 2 or if it is meant to be a separate and distinct conduit.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 12 and 13 (as understood) are rejected under 35 U.S.C. 102(b) as being anticipated by Mayer et al. (US Patent Number 5,996,549).

Mayer et al. disclose a flap device for influencing a flow cross-section in a medium-carrying conduit, comprising a control element (20, 22, 24, or 26) arrangeable in the conduit, at least one shaft portion having a first and a second end and of a cranked configuration in a region between the first and second ends (see Fig. 2), means mounting the shaft portion rotatably with respect to the conduit, and means operable to fix the control element in torsionally stiff relationship to the first end of the shaft portion (see column 2, line 57); and also including means adapted to fix a control element of a further flap device for a further conduit in torsionally stiff relationship to the second end of the shaft portion (see Figs. 1 and 2).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 4 and 6 (as understood) are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mayer et al.

Mayer et al. give a broad teaching of the torsionally stiff relationship, but are silent as to the method of manufacturing the connection. However, the patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product in the prior art, the claim is unpatentable even though the prior product was made by a different process (see MPEP 2113).

12. Claims 4, 12, and 13 (as understood) are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayer et al. in view of Hatton (US Patent Number 6,135,418).

Mayer et al. give a broad teaching of what would appear to be a torsionally stiff relationship, but are silent as to the specific press fit connection. Hatton discloses a flap device with multiple control elements connected to a shaft. Hatton discloses numerous methods of connecting the control element to the shaft (see column 5, lines 22-30) including press fitting (see column 5, line 30). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have assembled the control elements of Mayer et al. to the shaft by press fitting in order to secure the control element to the shaft as taught by Hatton.

13. Claims 6, 12, and 13 (as understood) are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayer et al. in view of Pearson et al. (US Patent Number 5,374,032).

Mayer et al. give a broad teaching of what appear to be a torsionally stiff relationship, but are silent as to the specific connection being a flattened portion of the shaft bearing against the control element. Pearson et al. disclose a flap device with a control element bearing against a flattened portion of the shaft (see Fig. 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have assembled the control element of Mayer et al. to the shaft so that a flattened portion of the shaft bears against the control element in order to provide a larger surface to transmit the torque to reduce the possibility of breakage as taught by Pearson et al.

*Response to Arguments*

14. Applicant's arguments filed January 18, 2005 have been fully considered but they are not persuasive.

Applicant argues that Mayer et al. do not disclose "an insert to be positioned...". The examiner disagrees. To the extent that applicant has described "an insert", the device of Mayer et al. can be considered an insert.

Applicant argues that Mayer et al. do not disclose a torsionally stiff relationship. The examiner disagrees. Mayer et al. explicitly disclose that the connection between the shaft (axle) and control elements (flaps) are non-rotatable. Since they do not rotate with respect to each other, they are torsionally stiff. Applicant has disclosed three types of connections that they consider to be torsionally stiff and these are all connections in which the shaft does not rotate with respect to the control element.

*Conclusion*

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37



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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Keasel whose telephone number is (571) 272-4929. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Mar can be reached on (571) 272-4906. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Eric Keasel 30 MAR 2005*

Eric Keasel  
Primary Examiner  
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